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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/632,808 | 08/04/2000 | Lawrence A. Denny | 1950.006 | 2511 |

30589 7590 11/16/2004

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,808

Applicant(s)

DENNY, LAWRENCE A.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to Amendment filed 07/23/04. Claims 1, 4-8 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al (6,202,923) in view of Kobylevsky et al (6,493,427).

(A) As per claim 1, Boyer discloses a method for verifying a renewal of a filled prescription provided by a member healthcare provider for a patient which can be filled through any one of a variety of member pharmacies with the member of healthcare provider being associated with a computer system having a web browser and each member pharmacy having a computer system with a web browser (Col.5, lines 8-67 to Col.6, line 59; Col.11, lines 1-67), comprising the steps of: providing a host system established as a website communicating with the Internet and available for login by member pharmacies and member healthcare providers, the host system including a plurality of records containing prescription information for a plurality of patients (Col.5, lines 8-67 to Col.6, line 59; Col.11, lines 1-67), a unique identification code generated

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by the host system identifying each prescription information, a unique healthcare provider code identifying the member healthcare provider, and a patient code uniquely identifying a patient, at least some of the records containing prescription information being indicative of filled prescriptions, the records containing prescription information being available to all member pharmacies and member healthcare providers (Col.5, lines 8-67 to Col.6, line 67; Col.11, lines 1-67);

providing electronically a prescription renewal screen by the host system to a pharmacy system associated with one of the member pharmacies, the prescription renewal screen being associated with a previously filled prescription (Col.5, lines 8-67 to Col.6, line 32);

receiving renewal request information from the pharmacy system, the renewal request information identifying a requested renewal of the previously filled prescription (Col.6, lines 5-67);

transmitting the renewal request information through the host system to a health care provider system associated with a member health care provider identified by the previously filled prescription stored on the host system (Col.6, lines 1-67).

Boyer does not explicitly disclose receiving, by the host system, an authorization from the health care provider system authorizing the requested renewal of the previously filled prescription; transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the requested renewal of the previously filled prescription to the patient.

However, these features are known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests receiving, by the host system, an authorization from the health care provider system authorizing the requested renewal of the filled prescription (Col.7, lines 10-67 to Col.8, line 34; Col.29, line 9-58); transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient (Col.7, lines 10-67 to Col.8, line 34 and Col.29, lines 9-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the motivation of providing the prescription which is authorized to be refilled (See Kobylevsky, Col.2, lines 50-67).

(B) As per claim 4, Kobylevsky discloses the method further comprising the step of outputting a report to a computer associated with a user other than a member healthcare provider or a member pharmacy (Col.29, lines 37-67 to Col.30, line 10).

(C) As per claim 5, Boyer discloses the method wherein the user is associated with a governmental entity (Col.11, lines 62-67).

(D) As per claim 6, Boyer discloses the method wherein the user is associated with an insurance company (Col.6, line 21-59).

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(E) As per claim 7, Boyer discloses the method wherein the report is summarized by the name of the prescribing member healthcare provider (Col.5, lines 38-67 to Col.6, line 32).

(F) As per claim 8, Boyer discloses the method further comprising the step of outputting a patient prescription history, wherein the patient prescription history includes previous patient prescriptions associated by at least one of a patient code, a healthcare provider code, and a pharmacy code (Col.6, lines 48-67).

Response to Arguments

4. Applicant's arguments filed on 07/23/04 with regard to claims 1, 4-8 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in order in which they appear in the response filed 07/23/04.

(A) At pages 2-9 of the 07/23/04 response, Applicant's argues the followings:

(1) Boyer and Kobylevsky do not disclose a method for verifying a renewal of a filled prescription provided by a member health care provider for a patient which can be filled through any one of a variety of member pharmacies with the member healthcare provider being associated with a computer system having a web browser and each member pharmacy having a computer system with a web browser.

(2) Boyer and Kobylevsky do not disclose, teach, or even suggest a method that provides the step of providing electronically a prescription renewal screen by the host system to a pharmacy system associated with one of the member pharmacies, the

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prescription renewal screen being associated with a previously filled prescription for bi-directional information flow between member health care providers and member pharmacies.

(3) Boyer and Kobylevsky do not disclose, teach, or even suggest a system where pharmacies and doctors have to be members to participate nor does Boyer in view of Kobylevsky teach the step at transmitting renewal information through the host system to a healthcare provider system.

(4) There is also no method in Boyer or Kobylevsky whether viewed, singularly or in combination, to notify the doctor if any fraud or diversion is occurring with one of the doctor's prescriptions.

(1) In response to applicant's first argument with respect to the applied prior art, the recitation "a method for verifying a renewal of a filled prescription provided by a member health care provider for a patient which can be filled through any one of a variety of member pharmacies with the member healthcare provider being associated with a computer system having a web browser and each member pharmacy having a computer system with a web browser" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand

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alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method/process steps are embodied or implemented on a “computer system” or on a “computer readable medium” (as appropriate), provided Applicant show proper support for such recitation in the originally filed specification. Examiner also notes that Boyer suggests an Internet connection which allows a pharmacist or patient to access information relating to the drug type/disease status, or patient self-care. The Internet connection can also be used to facilitate videoconferencing professionals and schools, for example (See Boyer, Col.11, lines 62-67). Therefore, Applicant’s argument is non-persuasive.

(2) With regard to Applicant’s second argument, Examiner respectfully submits that Kobylevsky suggests “Internet Server (IS) –computer that hosts RT Web site. Pharmacy customers can log on to the Web site from anywhere in the world and order their prescription refills. Orders, entered through the Internet are inserted into the Refill database on DS and the pharmacy can be notified either via fax (VFS) or modem” which correspond to Applicant’s claimed feature (See Kobylevsky, Col.24, lines 38-61). Therefore, Applicant’s claimed feature is not persuasive.

(3) With regard to Applicant’s third argument, Examiner respectfully submits that Boyer clearly teaches a system where several individuals such as pharmacists, data

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entry technician, doctors and others can communicate to several computers to form a group as Applicant's claimed feature (See Boyer, Col.1-32). Boyer also suggests "Upon receiving refill information via telephone 18 or physical prescription 2, data entry technician 24 enters the data into data entry workstation 5. The information received from prescription 2 and from the patient 3 contains, at a minimum, the patient's name, the patient's address, the physician's name, the type of drug, the dosage size of the drug, the quantity of drug, the date prescribed, physician's instructions to the patient, the number of refills allowed, and whether the substitution of a generic version of the drug is permitted by the physician" which correspond to Applicant's claimed feature (See Boyer, Col.5, lines 62-67 to Col.6, line 31). Therefore, Applicant's argument is not persuasive.

(4) With regard to Applicant's fourth argument, Examiner respectfully notes the limitation "to notify the doctor if any fraud or diversion is occurring with one of the doctor's prescriptions" has not been recited in the claims. Therefore, Applicant's argument is non-persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

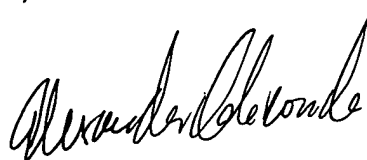
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

November 10, 2004



ALEXANDER KALINOWSKI
PRIMARY EXAMINER